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No. 322

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

ALEXANDER T. SPERRY, *Petitioner,*

v.

STATE OF FLORIDA, ex rel., THE FLORIDA BAR,
Respondent.

On Writ of Certiorari to the Supreme Court of Florida

BRIEF OF AMERICAN ASSOCIATION OF REGISTERED PATENT ATTORNEYS AND AGENTS, AMICUS CURIAE

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The petitioner and the respondent having consented in writing, the American Association of Registered Patent Attorneys and Agents files this brief as amicus curiae.

INTEREST OF AMICUS CURIAE

The American Association of Registered Patent Attorneys and Agents is an association of qualified and duly registered patent attorneys and agents who are not members of the bar. The purposes of the Associa-

tion are to maintain high professional standards among patent practitioners, and to protect their professional rights and privileges. The right of the members of the Association to continue their practice is threatened by the decision of the Supreme Court of Florida, which denies to similarly qualified individuals, not members of the Florida bar, the right to carry on such practice in Florida. It is plain, therefore, that the amicus curiae has a vital interest in the case at bar.

ARGUMENT

The amicus curiae supports the position of the petitioner and endorses the arguments advanced in the petitioner's brief. Without repeating these arguments, the amicus curiae wishes to add only a few words.

I

By its judgment, the Supreme Court of Florida has forbidden the petitioner to perform in Florida the very acts and functions which under an Act of Congress and valid rules of the Patent Office he has the right to perform. The lower court has thus attempted to nullify a law of Congress and destroy the powers conferred upon Congress by the Constitution, so far as they relate to a resident of Florida. We submit that the attempt must fail.

While disclaiming any intention to reflect upon the competence or integrity of the petitioner, the court below undertakes to justify the prohibition imposed upon him as a reasonable exercise of the police power of the state, to protect the public against incompetency and dishonesty on the part of patent practitioners. (R. 65-67) The court's argument does not withstand analysis; on the contrary, it is plain that the court's

injunction is not a reasonable exercise of the power of the state.

The petitioner in his brief has set out the relevant provisions of the Patent Act of 1952 (35 USC Sec. 31-33) and of the Rules of Practice of the United States Patent Office in Patent Cases (37 C.F.R. Sec. 1.31, 1.341-1.348). From the statute and the regulations, it will be seen that

(1) Agents—that is, nonlawyers—are specifically authorized to represent applicants before the Patent Office in the preparation and prosecution of applications for patent (35 USC Sec. 31; 37 C.F.R. Sec. 1.31).

(2) No agent is admitted to practice unless he establishes that he is of good moral character and repute, possesses the necessary legal, scientific, and technical qualifications, and is otherwise competent. An applicant for admission to practice must pass an examination, or must show that he has actively served for four years in the examining corps of the Patent Office (37 C.F.R. Sec. 1.341(c)). It may be noted parenthetically that patent examiners need not be members of the bar or trained in the law (See U.S. Civil Service Commission Announcement No. 181-B, issued February 10, 1959, revised October 1961).

(3) Agents appearing before the Patent Office must conform to the standards of ethical and professional conduct generally applicable to attorneys before the courts of the United States. They are specifically forbidden the use of any advertising to solicit patent business (37 C.F.R. Sec. 1.344, 1.345; See *Evans* v. *Watson*, 106 U.S. App. D.C. 108, 269 F. 2d 775, cert. den. 361 U.S. 900 (1959)).

(4) The regulations set up elaborate disciplinary procedures, providing for the investigation of complaints against patent practitioners, the preparation and service of charges, written answers to charges, hearings, and the suspension, disbarment or exclusion from practice of any respondent found guilty of misconduct (37 C.F.R. Sec. 1.348).

In the light of the elaborate and exhaustive regulatory structure set up by the Patent Act and the Rules of the Patent Office, it cannot be successfully argued that any additional or supplementary regulation by the state is necessary to protect the public. On the contrary, it is clear that the Federal government has completely occupied and pre-empted the field and that any additional regulation by the state is unnecessary and unreasonable.

It is difficult to understand, moreover, how one could demonstrate his competence to present and prosecute a patent application by passing a Florida state bar examination. Surely, a knowledge of the law of torts, domestic relations, criminal law, wills, real property, and the other subjects covered by a bar examination has no relevance to proceedings in the Patent Office. We venture to suggest also that the bar examiners of the State of Florida would find themselves quite incompetent and unable to evaluate the qualifications of a patent agent in the field of chemistry, physics, electronics, engineering or mechanical drawing.

The case of *Allen* v. *Riley*, 203 U.S. 347 (1906) is, we think, instructive and helpful in the consideration of the problem before the Court. In that case, the Court sustained a Kansas statute requiring one selling a patent right to file with the clerk of the district court

of his county authenticated copies of the letters patent together with an affidavit attesting the validity of the transaction and setting out other pertinent information. It was contended that the statute was unconstitutional in view of an act of Congress providing that patents should be assignable by an instrument in writing, to be recorded in the Patent Office. In upholding the state law, this Court said (203 U.S. 355):

> "We think the state has the power (certainly until Congress legislates upon the subject) with regard to the provision which shall accompany the sale or assignment of rights arising under a patent, to make reasonable regulations concerning the subject, calculated to protect its citizens from fraud. And we think Congress has not so legislated by the provisions regarding an assignment contained in the act referred to.
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> * * *
>
> "To uphold this kind of a statute is by no means to authorize any state to impose terms which, possibly, in the language of Mr. Justice Davis, in Ex parte Robinson, 2 Biss. 309, Fed. Cas. No. 11,932, 'would result in a prohibition of the sale of this species of property within its borders, and in this way nullify the laws of Congress which regulate its transfer, and destroy the power conferred upon Congress by the Constitution.' Such a statute would not be a reasonable exercise of the powers of the state."

In the case at bar, as we have seen, Congress has not only legislated upon the subject of practice before the Patent Office, but has completely pre-empted that field. The Florida court has attempted to nullify the law of Congress and destroy the power of Congress; and the decree of the Florida court is not a reasonable exercise of state power.

The doctrine which should govern the determination of this case is, we submit, well stated in the opinion of Vice-Chancellor Bigelow in *Auerbacher* v. *Wood*, 139 N.J. Eq. 599, 53 A. 2d 800, aff'd 142 N.J. Eq. 484 (1948). That case was a suit to enjoin the alleged unlawful practice of law by an industrial relations consultant who was not a member of the bar. In particular, the matter involved the defendant's practice before the National Labor Relations Board. In holding for the defendant, Vice-Chancellor Bigelow said (139 N.J. Eq. at 604):

> "Defendant also offers to represent the employer before administrative agencies of the federal government, especially before trial examiners of the National Labor Relations Board. An agency of the federal government, acting by virtue of an authority granted by the Congress, may regulate the representations of parties before such agency. *In re Lyon (Mass.), 16 N.E. Rep. (2d) 74.* The State of New Jersey is without power to interfere with such determination or to forbid representation before the agency by one whom the agency admits. The rules of the National Labor Relations Board give to a party the right to appear 'in person, or by counsel, or by other representative.' *Rules and Regulations, September 11, 1946,* § 203.31. 'Counsel' here means a licensed attorney, and 'other representative' one not a lawyer. In this phase of his work, defendant may lawfully do whatever the Labor Board allows, even arguing questions purely legal."

We may add that the right to practice before the Patent Office necessarily carries with it as a corollary the right to hold oneself out as qualified so to do. The Patent Act plainly recognizes the right of qualified patent practitioners to hold themselves out as so quali-

fied, by providing a criminal penalty for one who "not being recognized to practice before the Patent Office holds himself out or permits himself to be held out as so recognized." (35 U.S.C. Sec. 33). Yet the decree of the Supreme Court of Florida enjoins the petitioner from "holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments thereto". At the same time, the court disclaims any intention "to affect any rights which the respondent has to practice before the Patent Office when done outside this state." We submit that the Florida court has plainly overreached itself.

If the decision of the Florida court is sustained, rights created by Federal law will be at the mercy of any state that happens to be the geographical base from which they are exercised. As other states adopt restrictive measures either by legislation or by court decree, the District of Columbia may ultimately become the only jurisdiction in which a patent agent can practice his profession. That this foreboding is not chimerical is evidenced by a recent act of the Virginia Assembly, Acts of Assembly Va. 1962, Ch. 389, approved March 30, 1962 (S. 276). This act provides in part:

> "§ 1. So long as the U. S. Patent Office or any part or division thereof is located in Virginia, an attorney recognized to practice before the U. S. Patent Office in patent or trademark cases shall be authorized to practice patent or trademark law in Virginia without being licensed or authorized as an attorney at law in Virginia by the Supreme Court of Appeals or by the State Board of Bar Examiners, and without becoming a member of the Virginia State Bar.
>
> "§ 2. For the purposes of this act 'an attorney recognized to practice before the U. S. Patent

> Office in patent or trademark cases' is defined as any *one who is duly authorized to practice law in any state or territory of the United States, or the District of Columbia and who also is entitled under the rules of the U. S. Patent Office to represent another in a patent or a trademark case;* and to 'practice patent or trademark law' is defined to mean to perform all necessary professional services with respect to patent or trademark matters, concerning which being recognized to practice before the U. S. Patent Office for the performance of such services is required, and includes the preparation and filing of copyright applications and assignments thereof in the Copyright Office of the Library of Congress." (Emphasis added)

It is apparent that the Virginia Assembly, perhaps following the lead of Florida, has undertaken to impose state requirements and qualifications upon patent practitioners, in addition to those imposed by the Act of Congress and Rules of the Patent Office. One may conjecture that if the theory of such legislation is sustained the Virginia Assembly may well carry the principle to its logical conclusion by requiring lawyers at the Pentagon or at the headquarters of the Central Intelligence Agency to become members of the Virginia Bar.

We submit that the decree of the Supreme Court of Florida is an unconstitutional attempt to exercise control in a field pre-empted by Federal law, and an unreasonable extension of the police power of the state.

II

The amicus curiae challenges the conclusion of the Supreme Court of Florida that the preparation and prosecution of patent applications constitute the practice of law.

The preparation and prosecution of applications for patents require a high degree of technical training and skill but do not require legal training. What is necessary is a thorough knowledge of physics, mechanics, electronics, chemistry and kindred subjects. The work of preparing and prosecuting an application, in short, is the kind of work that may be and usually is done by a technician, rather than a lawyer. To be sure, matters and controversies arising after the issuance of a patent may well require the special skill and training of a lawyer; but this has nothing to do with the proceedings in the Patent Office prior to the issuance of a patent.

The amicus curiae recognizes that familiarity with the patent statutes and their interpretation is a prerequisite for competency in the preparation and prosecution of patent applications, even as familiarity with the pertinent city ordinances is necessary for a traffic patrolman. It may not be amiss to point out, however, that study of patent statutes is rarely, if ever, included in the regular curriculum of a law school nor is the subject commonly touched upon in the questions on a bar examination. Such matters, however, are the subject of a rigid examination to which candidates for admission to practice before the Patent Office, lawyers and nonlawyers alike, must submit before being accepted as qualified to represent applicants.

The Court below relies heavily upon the argument that a patent amounts to a contract between the inventor and the government, granting the patentee the exclusive right to vend and use his invention for a period of years. The Court reasons that since a contract is involved, the patent applicant must be represented by one having legal training and skill (R. 59-62). It should be pointed

out, however, that the terms of the grant of patent rights by the government are embodied in a standard printed form, in which only the name and address of the inventor are inserted by a a clerical employee of the Patent Office. The metes and bounds of the grant are, of course, defined by the claims and specifications of the patent application. The delineation of these metes and bounds—that is the preparation of the claims and specifications—does not require the skill and training of a lawyer, but involves rather the knowledge and skill of a scientist, an engineer, a mechanic, or a draftsman. By way of illustration, a patent may be compared with a grant of land by a common-law deed. The preparation of a deed may require a lawyer's knowledge, so that the desired estate may be conveyed, but the metes and bounds of the property to be conveyed are ascertained and stated by a surveyor skilled in his art, and not by a lawyer. So in the case of a patent, the terms of the grant from the government to the inventor are expressed in a standard printed form; the metes and bounds of the grant are set out in the claims and specifications prepared by a technician, and not necessarily by a lawyer.

The amicus curiae fully subscribes to the language quoted in the opinion below from *Topliff* v. *Topliff*, (145 U.S. 156, 1892), to the effect that the specifications and claims of a patent constitute a most difficult legal instrument to draw and that great harm may befall an inventor who entrusts their prepartion to a person lacking the requisite skill. It does not follow, however, that the type of skill required can be gained only or principally by the successful completion of a standard law course or that the needed abilities are demonstrated by a passing mark on a state bar exami-

nation. In fact, the contrary is true; it is no slur on the legal profession to point out that the great majority of its members lack the training in the natural sciences that is necessary for an understanding, *a fortiori* a drafting, of a patent specification or claim for any but the simplest invention.

Only slightly more than half the number of registered practitioners before the United States Patent Office (3900 out of 6777 in the year 1960) are holders of both legal and technical degrees; not all of them are members of the bar in the state in which they practice, and some (248 in 1960) are not admitted to any bar. The remainder is divided into practitioners without technical degrees (1544) and practictioners without legal degrees (1553).[1] Almost all of them, with the exception of those registered as patent attorneys prior to the year 1934 when qualifying examinations were introduced by the Patent Office, had to establish to the Commissioner's satisfaction their ability to represent inventors; there is no evidence that one type of practitioner, taken as a class, is less competent than any other in this respect. It is important to note also that examiners in the Patent Office, who pass initially on all applications for patents (See 37 C.F.R. 1.101, et seq), need not be lawyers and in most cases are not lawyers. They are required to have a science or engineering degree on a college level or its equivalent in experience, but there is no requirement that they be trained in the law. (See U. S. Civil Service Commission Announcement No. 181-B, issued February 10, 1959, revised October 1961, announcing examination for Patent Examiner).

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[1] Letter, June 1, 1962, from C. W. Moore, Solicitor, United States Patent Office, to Alexander T. Sperry.

The Florida decision here under review professes to have the inventor's interest at heart, yet if allowed to become the law of the land it would have the opposite effect. Persons of appropriate scientific and technical background would be discouraged or disqualified from taking the Patent Office examination, and fewer candidates for admission would be able to pass the test under present standards. The Patent Office would then be tempted to lower its standards and to certify "patent lawyers" of limited engineering knowledge who in turn would have to delegate their work to faceless specialists. Such a separation of responsibility and competence, we submit, should not be encouraged, much less tolerated.

CONCLUSION

In conclusion, the amicus curiae submits that the decision of the Supreme Court of Florida should be reversed.

Respectfully submitted,

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